

Appl. No. 09/988,691
Amdt. dated May 2, 2005
Reply to Office Action of February 1, 2005

REMARKS/ARGUMENTS

Applicant has received the Office Action dated February 1, 2005, in which the Examiner: 1) rejected claims 1-15 and 17-21 under 35 U.S.C. § 102(e) as allegedly anticipated by *Elliot et al.* (U.S. Pat. No. 6,826,247 B1); and 2) rejected claims 16, 22-35 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Elliot* in view of *Landman et al.* (U.S. Pat. No. 6,028,488).

With this Response, Applicant has amended claims 1, 11, 19, and 25,¹ canceled claims 8, 9, 10, and 23, and added new claim 36. Therefore, claims 1-7, 11-22, and 24-36 remain pending.

I. AMENDMENTS TO THE SPECIFICATION

Applicant has amended the specification at paragraphs [0010] and [0034] to correct minor clerical errors. Applicant respectfully submits that no new matter is added by these amendments.

II. REJECTIONS BASED ON *ELLIOT*

Each of the pending claims are rejected, either under § 102 or under § 103, using *Elliot*. Applicant respectfully traverses because *Elliot* fails to teach or suggest all of the claim elements for several reasons. For example, independent claim 25 requires "comparator logic that establishes threshold values ... and which generates a plurality of output enable signals based on said threshold values."

First, *Elliot* actually teaches against using comparators. Specifically, *Elliot* touts the advantages of the "edge selecting frequency synthesis circuit [being] much better than digital frequency synthesis circuits which in the past have used ... comparators to convert the sampled reference clock into an output clock." Col. 5, ll. 32-37 (emphasis added). Therefore, instead of suggesting the use of comparators, when read in its proper context, *Elliot* actually teaches against the use of comparators.

¹ Although claim 25 has been amended, Applicant respectfully submits that this amendment is made purely for clerical purposes so that the word "signal" is in its intended plural form of "signals". Thus, this amendment is not made for any reason related to the patentability of claim 25. Furthermore, amending claim 25 in this manner should not be construed as a narrowing amendment or as a relinquishment of claim scope.

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Second, *Elliot* simply does not teach or suggest generating threshold values during any part of the thermometer encoding process, let alone generating a plurality of output enable signals based on the threshold values. Although the Office Action summarily finds the generation of threshold values as "inherent" (e.g., Office Action at 4), Applicant respectfully traverses. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Despite the Office Action's blanket conclusion as to inherency, there is no factual support or technical reasoning that the threshold values—i.e., the allegedly inherent characteristic—necessarily flow from the teachings of *Elliot*. Accordingly, Applicant respectfully submits that the Examiner has failed to carry the burden of proof to establish a case of anticipation.

Notably, this blanket "inherency" assertion is also used throughout the Office Action in determining that the "threshold values" recited in claim 25 are obvious under § 103 over *Elliot* in view of *Landman*. Although, § 2144.03 of the M.P.E.P. allows the Examiner, in certain limited situations, to rely on logic and reasoning as rationale in support of a § 103 rejection, if the Examiner relies on logic in making rejections, the Examiner must provide sound technical reasoning to support his or her conclusion. Furthermore, § 2144.03 also affords the Applicants the opportunity to challenge the Examiner's logical assertion in the next Office Action. For at least the reasons set forth above, the Applicants respectfully submit that the Examiner's technical assertions as to whether the threshold values are "inherently taught" are too tenuous and respectfully request that the Examiner support the technical contention with an affidavit of sound technical reasoning. For at least these reasons independent claim 25, as well as its dependent claims, are not anticipated or rendered obvious by the cited art.

Appl. No. 09/988,691
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In addition, independent claims 1 and 19, as amended, contain various limitations that make those claims and their dependent claims patentable over the art of record. For example, claim 1 requires "comparator logic including a first comparator and a second comparator, and wherein said first comparator receives said binary output signal from said digital counter, and in response generates multiple threshold values." Claim 19 requires "wherein converting the binary count value includes establishing a plurality of threshold values corresponding to said binary count value signal."

Various of the dependent claims 2-7, 11-18, 20-22, and 24 are patentable for separate reasons as well. For example, claim 7 requires "the thermometer-coded output signal includes m output signals, and the binary output signal generated by the digital counter includes x output signals, and wherein the m output signals approximately equals 2^x ". Again, *Elliot* fails to explicitly teach or suggest this element and the Office Action is silent as to the technical reasoning as to why this claim element would be "inherent". Thus, claim 7 is not anticipated or rendered obvious for at least this additional reason.

III. CONCLUSION

In the course of the foregoing discussions, Applicant may have at times referred to claim elements in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other elements can be ignored or dismissed. The claims must be viewed as a whole, and each element of the claims must be considered when determining the patentability of the claims.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event that additional extensions of time are necessary to allow consideration of this paper, however, such extensions are

Appl. No. 09/988,691
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hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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